

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

Paper No. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RAGNAR R. AVERY, JEFFREY S. BAKER,
GERALD A. BEELER, MICHAEL H. BROWN
and KEVIN J. OKESON

Appeal No. 1998-1159
Application 08/642,019

ON BRIEF

Before KIMLIN, WARREN and DELMENDO, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

We have carefully considered the record in this appeal under 35 U.S.C. § 134, including the opposing view of the examiner, in the answer, and appellants, in the brief, and based on our review, find that we cannot sustain the ground of rejection of appealed claims 1 and 4 through 15 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention, or the ground of rejection of appealed claims 1 and 4 through 16 under 35 U.S.C. § 103(a) as being unpatentable over Groenhof in view of Keil,

McGraw, Guarancio et al. and Malito, which grounds encompass all of the claims in the application.¹ We determine that the examiner has failed to make out a *prima facie* case in these grounds of rejection for the reasons pointed out by appellants in the brief, to which we add the following.

With respect to the ground of rejection under § 112, second paragraph, the initial burden of establishing a *prima facie* case on any ground under this statutory provision rests with the Examiner. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992), citing *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984) (“As discussed in *In re Piasecki*, the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.”). In making out a *prima facie* case of non-compliance with this statutory provision on the basis that the claims are indefinite for failing to particularly point out and distinctly claim the subject matter which appellants regard as the invention, the examiner must establish that when the language of the appealed claims is considered as a whole as well as in view of the specification as it would be interpreted by one of ordinary skill in the art, the claims in fact fail to set out and circumscribe a particular area with a reasonable degree of precision and particularity. *In re Moore*, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). In other words, the operative standard for determining whether § 112, second paragraph, has been complied with is “whether those skilled in the art would understand what is claimed when the claim is read in light of the specification.” See *The Beachcombers, Int’l. v. WildeWood Creative Prods.*, 31 F.3d 1154, 1158, 31 USPQ2d 1653, 1656 (Fed. Cir. 1994), quoting *Orthokinetics Inc v. Safety Travel Chairs Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986). We fail to find in the examiner’s stated position (answer, pages 3 and 5) any reason why one of ordinary skill in this art would not understand what is claimed in the absence of a limitation in claim 1 with respect to the viscosity of the blend of polysiloxanes (A) and (B). Indeed, one of ordinary skill in this art would understand that a blend of polysiloxanes wherein the individual polysiloxanes satisfy the limitations with respect to polysiloxanes (A) and (B), and which further satisfies the polydispersity requirement, will satisfy the claim as long as ingredient (C) is satisfied. Thus, we reverse this ground of rejection.

¹ See, e.g., the amendment of January 27, 1997 (Paper No. 6), and January 30, 1997 (Paper No. 7).

With respect to the ground of rejection under § 103(a), it is well settled that a *prima facie* case of obviousness is established by showing that some objective teaching, suggestion or motivation in the applied prior art taken as a whole and/or knowledge generally available to one of ordinary skill in the art would have led that person to the claimed invention as a whole, including each and every limitation of the claims, without recourse to the teachings in appellants' disclosure. *See generally, In re Rouffet*, 149 F.3d 1350, 1358, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998); *Pro-Mold and Tool Co. v. Great Lakes Plastics Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629-30 (Fed. Cir. 1996); *In re Fine*, 837 F.2d 1071, 1074-76, 5 USPQ2d 1596, 1598-1600 (Fed. Cir. 1988); *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988); *In re Warner*, 379 F.2d 1011, 1014-17, 154 USPQ 173, 175-78 (CCPA 1967).

The examiner's position is based on the erroneous view that the definitions of members R¹ and R² of the formula set forth in claim 1 "are alkyl radicals of 1 to 6 carbon atoms which read on phenyl groups which contain 6 carbon atoms," because an "alkyl" radical is not a "phenyl" radical and it is clear from the written description in appellants' specification with respect to these formula members that appellants did not define "alkyl" to include "an aryl group such as phenyl" (page 7). *See generally, In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989), ("During patent prosecution the pending claims must be interpreted as broadly as their terms reasonably allow. When the applicant states the meaning that the claim terms are intended to have, the claims are examined with that meaning, in order to achieve a complete exploration of the applicant's invention and its relation to the prior art. [Citations omitted.]"). Furthermore, Groenhof discloses mixing a polydimethylsiloxane oil with a phenylmethylsiloxane/dimethylsiloxane copolymer, characterized as a gum (e.g., col. 1, line 64, to col. 3, line 8, col. 3, lines 32-33, and col. 4, lines 42-44), which copolymer does not fall within the structural formula in appealed claim 1. While Keil discloses that the "polydiorganosiloxane" of 10-100 centistokes can be prepared by mixing two such polysiloxanes with different viscosities (col. 3, line 51, to col. 4, line 3), it is not apparent from this record that this teaching alone would have reasonably provided a suggestion leading one of ordinary skill in this art to select the polysiloxanes specified by appealed claim 1 and blend the same to arrive at the polydispersity for the blend specified in claim 1. Thus, the blend of Keil as used in the compositions disclosed therein or as substituted for the polydimethylsiloxane oil of Groenhof would not

result in the claimed composition encompassed by appealed claim 1. Thus, we reverse this ground of rejection.

The examiner's decision is reversed.

Reversed

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
)	
)	
)	
CHARLES F. WARREN)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
)	
ROMULO H. DELMENDO)	
Administrative Patent Judge)	

Appeal No. 1998-1159
Application 08/642,019

Patent Department Mail C01232
Dow Corning Corporation
Midland, MI 48686-0994